



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/635,506 | 08/09/2000 | Scott Faber | 004704.P004 | 5692 |

7590 04/01/2004

Glenn E Von Tersch
Blakely Sokoloff Taylor & Zafman L L P
12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-1026

EXAMINER

MEINECKE DIAZ, SUSANNA M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3623

DATE MAILED: 04/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/635,506

Applicant(s)

FABER ET AL.

Examiner

Susanna M. Diaz

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-96 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-96 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 19.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Final Office action is responsive to Applicant's amendment filed January 20, 2004.

Claims 1, 47, 61, and 75 have been amended.

Claims 1-96 are pending.

Terminal Disclaimer

2. The terminal disclaimers filed on January 20, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent Nos. 6,223,165; 6,523,010; 6,546,372; and 6,549,889 have been reviewed and are accepted. The terminal disclaimers have been recorded.

Response to Arguments

3. Applicant's arguments filed January 20, 2004 have been fully considered but they are not persuasive.

Applicant's arguments center around the assertion that Expertcity.com "bases billing on the expert's time spent on the problem, not the expert's time spent linked to the user" (Page 26 of Applicant's response). However, the claims do not recite any functionality or means directed toward actually measuring the amount of time spent by a customer linked directly to a service provider and then billing solely based on this quantified amount of time spent (e.g., 3 minutes, 1 hour, etc.). Therefore, the recited "service provider rate" is not necessarily limited to an amount spent by the service

Art Unit: 3623

provider linked to a customer (e.g., \$1 per minute). Instead, Expertcity.com allows service providers to bid for the right to serve a customer. There is an understood rate in this bid, be it associated with a charge per unit of time or an overall charge to finish providing the desired help. "Rent-An-Expert on the Web" gives the specific example of a rate of "\$50 per hour, meaning that people will pay about \$8 for 10 minutes of technical support" (¶ 6). Furthermore, "Rent-An-Expert on the Web" details a technical support scenario in which an "adviser can then either instruct the user how to fix the problem or take over the customer's PC and repair it remotely" (¶ 4). There is no mention of the technical support adviser in this scenario charging the customer for preparation time to ponder the problem. The adviser offers the hands-on solution of accessing the customer's PC remotely, thereby exemplifying how the adviser is effectively charging the customer based on the period of time during which the technical support adviser is linked to the customer's PC in order to remedy the customer's PC problem. Therefore, in this scenario, the customer is effectively billed based on the fact that the technical support adviser spent "time during which link to the first [or second] customer is maintained," as recited in the independent claims.

In conclusion, Applicant's arguments are not persuasive and the standing rejection is maintained.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Expertcity.com's Internet service, as disclosed in "Expertcity.com Launches Premier Online Marketplace for Expert Services" (which states that the Expertcity.com web site was launched on August 30, 1999) and "Rent-An-Expert on the Web," in view of Weinstein et al. (US 2001/0026609 A1).

Expertcity.com discloses a method comprising:

[Claim 1] displaying a service provider and a service provider rate for communicating with the service provider and a real-time indication of whether the service provider is available ("Rent-An-Expert on the Web": ¶¶ 3, 4, 6 -- Experts who respond with bids are deemed to be currently available to assist the customer);

receiving a request from a first customer to communicate with the service provider ("Rent-An-Expert on the Web": ¶ 3);

connecting the first customer to the service provider through a link capable of transmitting from the service provider to the first customer ("Rent-An-Expert on the Web": ¶ 4);

receiving a request from a second customer to communicate with the service provider ("Rent-An-Expert on the Web": ¶¶ 3, 4, 6 -- As long as the expert stays online and he/she is deemed to be available, he/she connects with customer after customer one at a time, i.e., a first customer, second customer, etc.; therefore, it is understood

that the expert is connected to a customer any time the expert is online and a customer desires to communicate with him/her); and

connecting the second customer to the service provider through a link capable of transmitting from the service provider to the second customer ("Rent-An-Expert on the Web": ¶¶ 3, 4, 6 -- As long as the expert stays online and he/she is deemed to be available, he/she connects with customer after customer one at a time, i.e., a first customer, second customer, etc.; therefore, it is understood that the expert is connected to a customer any time the expert is online and a customer desires to communicate with him/her);

billing the first customer automatically based on the time during which the link to the first customer is maintained ("Rent-An-Expert on the Web": ¶ 6); and

billing the second customer automatically based on the time during which the link to the second customer is maintained ("Rent-An-Expert on the Web": ¶ 6 -- As long as the expert stays online and he/she is deemed to be available, he/she connects with customer after customer one at a time, i.e., a first customer, second customer, etc.; therefore, it is understood that the expert is connected to a customer any time the expert is online and a customer desires to communicate with him/her);

[Claim 3] wherein the link from the service provider to the first customer is implemented through use of the Internet ("Rent-An-Expert on the Web": ¶ 2);

[Claim 4] wherein the link from the service provider to the first customer is configured to transmit from the first customer to the service provider ("Rent-An-Expert on the Web": ¶¶ 3, 4);

[Claim 5] the first customer paying an intermediary and the second customer paying the intermediary, the intermediary receiving the requests, the intermediary connecting the service provider to the first customer, the intermediary connecting the service provider to the second customer, the intermediary performing the billing ("Rent-An-Expert on the Web": ¶ 6 -- Expertcity.com connects the customers and the experts and keeps "an undisclosed percentage of the fee," thereby implying that the billing goes through Expertcity.com);

[Claim 6] the intermediary having a set of service providers including the service provider ("Rent-An-Expert on the Web": ¶ 2); and

the intermediary performing the providing in response to a choice by the first customer of the service provider from the set of service providers ("Rent-An-Expert on the Web": ¶ 4);

[Claim 7] wherein the link from the service provider to the first customer is implemented through use of the Internet or through use of telephone connections ("Rent-An-Expert on the Web": ¶ 2);

[Claim 8] wherein the link from the service provider to the first customer is configured to transmit from the first customer to the service provider ("Rent-An-Expert on the Web": ¶¶ 3, 4);

[Claim 9] moderating transmissions from the service provider and transmissions from the first customer ("Rent-An-Expert on the Web": ¶¶ 3, 4);

[Claim 10] wherein the moderating is performed by the service provider ("Rent-An-Expert on the Web": ¶¶ 3, 4);

[Claim 11] wherein the moderating is performed by a moderator ("Rent-An-Expert on the Web": ¶¶ 3, 4);

[Claim 12] further comprising the moderator receiving a request from the first customer to transmit to the service provider ("Rent-An-Expert on the Web": ¶¶ 3, 4);

[Claim 19] wherein the request from the first customer to transmit to the service provider pertains to transmitting a question to the service provider ("Rent-An-Expert on the Web": ¶¶ 3, 4);

[Claim 21] receiving a request from the second customer to transmit a question to the service provider ("Rent-An-Expert on the Web": ¶¶ 3, 4);

[Claim 23] removing the first customer from the link between the first customer and the service provider, the removing performed by the moderator ("Rent-An-Expert on the Web": ¶¶ 3, 4 -- It is understood that the connection is ended when either the expert, customer, or server hangs up/disconnects).

As per claim 1, Expertcity.com teaches an expert system wherein multiple customers (one-at-a-time) can pay to communicate with an expert, i.e., a service provider; however, Expertcity.com fails to explicitly teach the connection of both a first and second customer to a service provider at the same time. Weinstein makes up for this deficiency in his teaching of "group expert calls" (¶¶ 112, 115). An expert offers a scheduled time during which various customers can pay for the opportunity to participate in a group call with the expert. These group expert calls "facilitate the more equitable marketing of people's time on the phone" (¶ 25), thereby providing an easily

Art Unit: 3623

accessible forum for experts to market their revenue-generating services. Both Expertcity.com and Weinstein provide readily accessible forums where experts can market their services to the public; therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to implement Weinstein's group expert call feature with Expertcity.com's expert system such that an expert can consult with both a first and second customer at the same time in order to facilitate the more equitable marketing of the experts' time on the phone, thereby providing an easily accessible forum for experts to market their revenue-generating services.

Regarding claims 2, 14-16, and 18, Expertcity.com fails to expressly teach that the customers may converse with an expert, such as through the use of telephone connections. However, Official Notice is taken that it is old and well-known in the art of communications to enhance Internet communications with voice capabilities so that two users connected via the Internet can converse with one another. Furthermore, many Internet users connect to the Internet through a modem that dials up to the Internet through a telephone line. These voice capabilities via the Internet (and ultimately through a telephone line) reap the benefits of facilitating oral communications, which in and of themselves are more efficient timewise for conveying ideas than written communications, at cheaper rates (as compared to making a long-distance call directly through the telephone). Expertcity.com performs the generic functionality (e.g., connecting the customers to experts, receiving payment based on the connection time, etc.) of claims 2, 14-16, and 18 (see "Rent-An-Expert on the Web": ¶¶ 3, 4, 6;

"Expertcity.com Launches Premier Online Marketplace for Expert Services": ¶ 11).

Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to enhance Expertcity.com's generic functionality (e.g., connecting the customers to experts, receiving payment based on the connection time, etc.) corresponding to claims 2, 14-16, and 18 with voice capabilities so that two users connected via the Internet can converse with one another through telephone lines in order to reap the benefits of facilitating oral communications, which in and of themselves are more efficient timewise for conveying ideas than written communications, at cheaper rates (as compared to making a long-distance call directly through the telephone).

As per claims 13 and 20, Expertcity.com permits the first customer to transmit a question to the service provider ("Rent-An-Expert on the Web": ¶¶ 3, 4). The customer is charged based on the time connected to an expert ("Rent-An-Expert on the Web": ¶ 6); however, Expertcity.com fails to expressly teach other variations of payment requirements, such as receiving payment from the customer for transmitting a question to the service provider (as per claim 20) and allowing the customer to contact the service provider upon payment to the intermediary (as per claim 13). Official Notice is taken that it is old and well-known in the art to charge a customer on a per-service basis. For example, service providers often assess service fees to encourage customers to consolidate service requests, thereby allowing the service providers to more efficiently plan for and provide their services to various customers. Further, Official Notice is taken that it is old and well-known in the art to request payment before

services are rendered in order to help ensure that a service provider is adequately and timely paid for services rendered. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to implement with Expertcity.com the step of receiving payment from the customer for transmitting a question to the service provider (as per claim 20) in order to encourage customers to consolidate service requests, thereby allowing the service providers to more efficiently plan for and provide their services to various customers. Further, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to implement with Expertcity.com the step of allowing the customer to contact the service provider upon payment to the intermediary (as per claim 13) in order to help ensure that a service provider is adequately and timely paid for services rendered.

Furthermore, as per claims 17 and 22, Weinstein discloses a waiting list feature with his group expert call system (§ 115). This feature allows new participants to enter a group expert call when other participants disconnect, thereby increasing profit for an expert who is charging each participant by the minute. Expertcity.com teaches that customers are charged per minute of connection time ("Rent-An-Expert on the Web": § 6); therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to utilize Weinstein's waiting list feature to enable Expertcity.com's moderator to queue requests to converse with the service provider (as per claim 17) as well as requests to transmit questions to the service provider (as per claim 22) in order to allow new participants to enter a group expert call

Art Unit: 3623

when other participants disconnect, thereby increasing profit for an expert who is charging each participant by the minute.

[Claims 24-46] Claims 24-46 recite limitations already addressed by the rejection of claims 1-23 above; therefore, the same rejection applies.

[Claims 47-60] Claims 47-60 recite limitations already addressed by the rejection of claims 1-23 above; therefore, the same rejection applies.

[Claims 61-74] Claims 61-74 recite limitations already addressed by the rejection of claims 1-23 above; therefore, the same rejection applies.

[Claims 75-96] Claims 75-96 recite limitations already addressed by the rejection of claims 1-23 above; therefore, the same rejection applies.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Deep (U.S. Patent No. 6,393,412) -- Discloses a system in which a third party bills a user for the amount of time connected to a service provider in a chat room.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

Art Unit: 3623

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450**

or faxed to:

(703)305-7687 [Official communications; including
After Final communications labeled
"Box AF"]

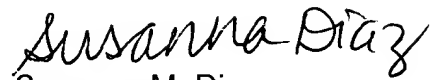
(703)746-7048 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Application/Control Number: 09/635,506

Page 13

Art Unit: 3623

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 22202, 7th floor receptionist.



Susanna M. Diaz
Primary Examiner
Art Unit 3623
March 29, 2004